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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,369	01/26/2001	Joseph Goldenburg	CNA-900	7923

7590 09/20/2002
CIENA Corporation
Legal Department
1201 Winterson Rd.
Linthicum, MD 21090

EXAMINER

PRASAD, CHANDRIKA

ART UNIT	PAPER NUMBER
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2839

DATE MAILED: 09/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/770,369

Applicant(s)

GOLDENBURG ET AL.

Examiner

Chandrika Prasad

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5, 19 and 21-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Mulholland et al.

Mulholland (Figures 1-4) shows an apparatus and method of attenuating electrostatic discharge comprising a rectangular conductive faceplate 72 with an opening 76 and a rectangular faceplate extension 71 extending outwardly from the periphery of the opening to form a waveguide wherein optical fiber connector 1, which can receive and/or transmit (transceiver) signals, communicate through the faceplate extension.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mulholland et al. in view of Terada et al.

Mulholland et al. shows all the features of this claim as described in Paragraph 2 above except the material of the faceplate extension to be aluminum alloy. Terada discloses the use of aluminum alloy for an optical fiber ferrule holder 51 (Page 7, Paragraph 82). It would have been obvious to one having ordinary skill in the art at the time of the instant invention to make the Mulholland's faceplate extension of aluminum alloy because of its linear expansion properties as taught by Terada.

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mulholland et al..

Mulholland et al. shows all the features of this claim as described in Paragraph 2 above except the faceplate extension to project at least 0.2 inches from the faceplate. The instant invention does not provide any specific problem to be solved by making the faceplate projection at least 0.2 inches. It would have been obvious to one having ordinary skill in the art at the time of the instant invention to make faceplate projection at least 0.2 inches because a change in size is generally recognized within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mulholland et al.

Mulholland et al. shows all the features of this claim as described in Paragraph 2 above except the faceplate extension to be circular. The instant invention does not provide any reasons or specific problems to be solved by making the faceplate extension circular. It would have been obvious to one having ordinary skill in the art at the time of the instant invention to make faceplate extension circular because circular

and rectangular are two of the most widely used configuration and selecting one configuration over the other is generally recognized within the level of ordinary skill in the art. *Graham v. John Deere co.* 383 U.S. 1, 148 USPQ 459.

7. Claims 9-13 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mulholland et al. in view of Applicant admitted prior art (AAPA).

Mulholland et al. shows all the features of these claims as described in Paragraph 2 except a plurality of openings in the faceplate and a plurality of faceplate extensions. AAPA (Figures 1-2 of the instant invention) shows a plurality of openings 16 in the faceplate 10. It would have been obvious to one having ordinary skill in the art at the time of the instant invention to provide a plurality of openings in the Mulholland et al.'s faceplate and to use a plurality of faceplate extensions because this would require a mere duplication of an essential part which involves only routine skill in the art. *St. Regis Paper Co. v Bemis Co.*, 193 USPQ 8.

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mulholland et al. and Terada et al. and further in view of AAPA. .

Mulholland et al. and Terada show all the features of this claim as described in Paragraph 4 except a plurality of openings in the faceplate and a plurality of waveguide extension. AAPA (Figures 1-2 of the instant invention) shows a plurality of openings 16 in the faceplate 10. It would have been obvious to one having ordinary skill in the art at the time of the instant invention to provide a plurality of openings in the Mulholland et al.'s faceplate and to use a plurality of faceplate extensions because this would require

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a mere duplication of an essential part which involves only routine skill in the art. St.

Regis Paper Co. v Bemis Co, 193 USPQ 8.

9. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mulholland et al. in view of AAPA. .

Mulholland et al. shows all the features of this claim as described in Paragraph 5 except a plurality of openings in the faceplate and a plurality of faceplate extension. AAPA (Figures 1-2 of the instant invention) shows a plurality of openings 16 in the faceplate 10. It would have been obvious to one having ordinary skill in the art at the time of the instant invention to provide a plurality of openings in the Mulholland et al.'s faceplate and to use a plurality of faceplate extensions because this would require a mere duplication of an essential part which involves only routine skill in the art. St. Regis Paper Co. v Bemis Co, 193 USPQ 8.

10. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mulholland et al. in view of AAPA

Mulholland et al. shows all the features of this claim as described in Paragraph 6 except a plurality of openings in the faceplate and a plurality of faceplate extension. AAPA (Figures 1-2 of the instant invention) shows a plurality of openings 16 in the faceplate 10. It would have been obvious to one having ordinary skill in the art at the time of the instant invention to provide a plurality of openings in the Mulholland et al.'s faceplate and to use a plurality of faceplate extensions because this would require a mere duplication of an essential part which involves only routine skill in the art. St. Regis Paper Co. v Bemis Co, 193 USPQ 8.

Double Patenting

11. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

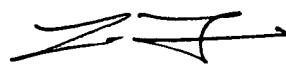
12. Claim 22 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 21 of copending Application No. 09/770,368. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Contact Information

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chandrika Prasad at (703) 308-0977. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn Feild, can be reached at (703) 308-2710. The fax number for this Group is (703) 872-9318 (general) and (703) 872-9319 for after-final. Any inquiry of a general nature should be directed to the Group receptionist at (703) 308-1782.


Chandrika Prasad

September 12, 2002


LYNN D. FEILD
PRIMARY EXAMINER